

### REMARKS

This Request for Reconsideration is filed in response to the Office Action mailed on 13 December 2005. The Applicant respectfully requests reconsideration of the present application in light of the arguments provided herein.

*In the Office Action of 23 August 2005, the Examiner allowed claims 39-50 and indicated the allowability of objected claims 17, 19, 23, 27, 30, and 32 merely as being dependent upon a rejected base claim.* In response, the Applicant respectfully acknowledges the Examiner's assessment of these claims and submits that the present invention defined by such claims should be provided with a broad scope of coverage as warranted by law.

*In the same Office Action, the Examiner rejected other claims of the patent application under 35 U.S.C. Sect. 103(a) based on U.S. Patent No. 5,613,213 to Naddell et al. in combination with other references such as U.S. Patent Publication No. 2004/0192301 to Shi and U.S. Patent Publication No. 2003/0069019 to Schwinkle.* In response, the Applicants respectfully disagree and submit that all such claims are allowable over the prior art of record for at least the following reasons.

For rejections under 35 U.S.C. §103, the prior art (individually or in combination) must teach or suggest each and every limitation in the claims. In addition, there must be some suggestion or motivation to combine the references to achieve the claimed invention.

For one, there is no suggestion or motivation to combine the teachings of Naddell et al. and Shi as asserted by the Examiner. As provided herein, some of the claims of the present application are specifically directed to *assigning priority to a network* in a priority list or network selection list in an automatic network selection technique of the mobile communication device. In the Office Action, the Examiner states that "it would have been obvious to a person of ordinary skill in the art to combine the teaching of Naddell et al with the teaching of Shi of assigning priority to a network that makes the

data communication service available over a network that fails to make the data communication service available to automatically designate the wireless network that can best support the user's call without the user need to know which network is being used."

The Applicants respectfully disagree with the Examiner's § 103 rejection. Naddell et al. is directed to providing an easy-to-assess *visual display* to make the *user selection process* more useful and efficient. There is no adequate suggestion or motivation to combine the teachings of Shi with that of Naddell et al., because Shi's disclosure to "automatically designate the wireless network that can best support the user's call without the user needing to know which network is being used" teaches away from the primary intent of Naddell: to provide the easy-to-assess visual display to make the user selection process more useful and efficient. The primary objective in Naddell et al. would be defeated as there would no longer be a need to *display* indications when network services are available or unavailable. The result would be that the user's discretion or choice in selecting a network would be *taken away* (see e.g. 1:22-26: "Private system radios are routinely preprogrammed with over 200 options. Users need a way to quickly sort through only the valid choices of sites and options when they operate their radio to choose a mode of operation."). The present invention as defined by claims 6, 12, 33, and 38 further relates to use of *a network selection list for use in an automatic network selection technique* in which the mobile communication device itself selects the communication network that is best for the device. The term "automatic network selection" is a term of art which one ordinarily skilled in the art will readily appreciate.

Secondly, Schwinkle fails to teach the limitation of "determining which communication networks make a data communication service available to the mobile communication device in the geographic coverage area *based on an attempt to access the data communication service through each communication network.*" At most, Schwinkle may be said to teach an attempt to access a *voice channel* of a network. On the other hand, the data communication service of the present application may be an e-mail service, an Internet access service, GPRS, etc. Attempting to access a voice channel and attempting to access a data communication service are two different things.

Even if Schwinkle were considered to teach such limitation (which it does not), there is no suggestion or motivation to combine such teaching with Naddell et al. As indicated above, Schwinkle may be said to teach an attempt to access a voice channel of a network. However, the attempt to access the voice channel is made in response to the initiation of a call request for voice telephony, for example. If this teaching of Schwinkle were combined with the teachings of Naddell et al., then call attempts might be utilized in step 304 of FIG. 3 of Schwinkle for each and every system in range. The Applicants respectfully submit, however, that any suggestion to utilize such a burdensome technique (the purpose of which would be unclear) would be remote if not entirely lacking. Further, Naddell et al. teach that the system itself may provide detection of service availability, thus obviating the need for the communication unit to make any such system availability determination.

As apparent, the invention as defined by at least some of the claims is directed to mobile station techniques for preferentially selecting networks that make a *data communication service* available where data service availability is determined based on actual attempts to access the data communication services through these networks. The prior art does not teach or suggest such techniques. For example, Naddell et al. teach a technique for displaying services associated with various communication systems so that an end user may choose which system to utilize. The services of each communication system are obtained based only on status indicators transmitted from the system. As one ordinarily skilled in the art may appreciate, even though a status indicator may indicate that a service is made available by a communication system, *a mobile communication device may still not be granted access to that service by the communication system*. In Naddell et al., no teaching or suggestion of making attempts to access the communication service in the communication system to identify whether the service is actually made available exists. In fact, Naddell et al. teach away from such technique (see e.g. col. 4 at lines 55-57: "communication unit 108 may then display an indication of the associated services under the assumption that these are all available at the time"). Further, Naddell

et al. teach that the system may provide the detection of service availability, thus obviating the need for the mobile unit to make any such determination.

According to the present application, a mobile station gains such data service availability "knowledge" at least in part through its own actual "experience" in connecting with the networks. See e.g. page 23 at lines 31-33 through page 24 at lines 1-28, and page 25 at lines 21-22. This is advantageous, as real-time knowledge of the availability of network services may otherwise be difficult to obtain. The mobile station is the entity that maintains network selection control and has a fixed bias for preferentially selecting those networks that actually make the data communication service available to it. Similar limitations of claim 1 are recited in independent claims 8, 13 and 38.

Based on the above, the Applicant respectfully requests the Examiner to withdraw all Section 103 rejections and allow all claims 1-50. The Applicant respectfully submits that the present application is now in a condition suitable for allowance based on the claim amendments and arguments presented herein.

Thank you. The Examiner is welcome to contact the undersigned if necessary to expedite prosecution of the present application.

Date:

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Respectfully submitted,

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